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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,379	06/20/2003	Steve B. Taylor	2236.001	7549

7590 03/22/2005

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,379

Applicant(s)

TAYLOR, STEVE B.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

In view of the Appeal Brief filed on 1/10/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "36" and "40" have both been used to designate "ball washer assemblies" as described in the Specification (p.7, ll.8-9). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

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accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for mounting means including one or more ball washers assemblies (Specification, p.4, ll.1-2 and p.7, ll.8-9), does not reasonably provide enablement for “a plurality of ball washer assemblies combinable with the mounting means” (line 4 of claim 11). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The problem posed by claim 11 is that it requires a plurality of ball washer assemblies that are not the means for mounting (as provided for in the Specification) but rather are combinable with the means for mounting. The Examiner notes that a means for mounting that consists of a plurality of ball washers is only one preferred embodiment (p.7, ll.8-9) such that an equivalent means for mounting that is not one or more ball washers can be used. However the specification does not adequately describe any such equivalent means for mounting much less describe how a plurality of ball washers could be combined with such an equivalent means for mounting.

Claim Rejections - 35 USC § 102

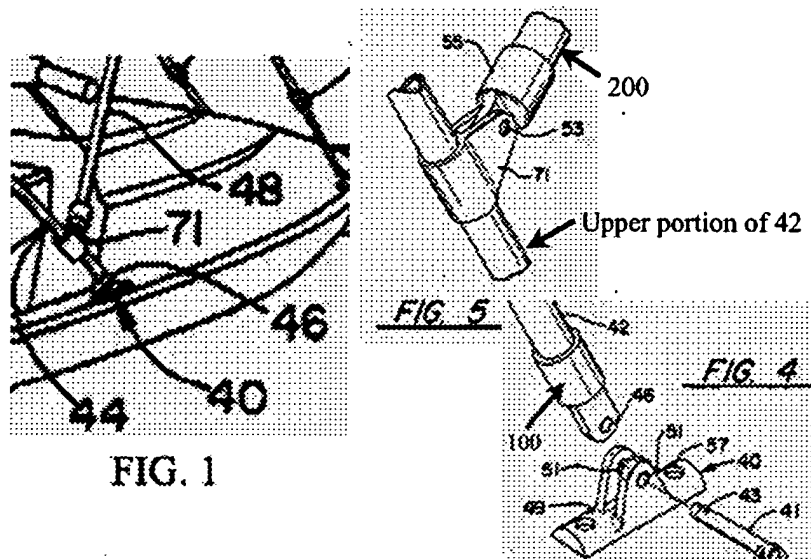
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray U.S.

Patent 5697320 (see marked-up figures below).



Claim 1. Murray discloses (figs. 1, 4, 5) a variably positionable coupler mountable on a curved surface, comprising: a base (40) formed with an upper side and a lower side, wherein the lower side is a substantially flat planar surface; means (57) for mounting the base on the curved surface (curved surface of the watercraft as seen in figure 1); a tub (100) adjustably connectable to the base; a plug [42 (including upper portion of 42) and 71] repositionably attachable to the tub; a neck (55) rotatably insertable in the plug [42 (including upper portion of 42) and 71], wherein the neck is formed for securing a shaft (200) to the neck; and a clevis mechanism (clevis

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connection between 55 and 71) slidably and demountably engageable with the plug and the neck. (Note that while the Murray curved surface does not curve at its point of contact with element 40, it does curve elsewhere and is thus a curved surface within the broadest reasonable interpretation of the claim language).

Claim 2. Murray discloses opposing yokes (tab portions of 40 receiving 41) monolithically extending at substantially right angles from the upper side of the base.

Claim 3. Murray discloses one or more bores (51) formed in the base with a proximal end and a distal end, and further wherein the one or more bores are shaped for removable engagement with a bolt (41). The word "bolt" is taken by the Examiner to mean, "a metal rod or pin for fastening objects together" in accordance with Merriam-Webster's Collegiate Dictionary Tenth Edition.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Landgrebe U.S. Patent 5704749.

Claim 4. Murray does not disclose a frustoconical recess. Landgrebe teaches (fig.1 and cols.3-4) a frustoconical recess (35, 55) formed adjacent the proximal end of one or more bores (portion of B receiving A), which is beneficial for improving the alignment of a fastener within a

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bore during assembly (col.4, ll.1-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the coupler of Murray to include, frustoconical recesses, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Landgrebe U.S. Patent 5704749, as applied to claim 4 above, and further in view of Schroeder U.S. Patent 1257536.

Claim 5. Murray discloses that the means for mounting comprises a plurality of holes but does not specify what type of fasteners and washers are used. Murray further suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs.1 and 2) a means for mounting that includes a ball washer assembly received in a concave cup (portion of 4 receiving 8) formed adjacent a distal end of one or more bores (hole portion of 4 receiving 10). Schroeder states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to adapt the Murray means for mounting to a land vehicle, as suggested by Murray, by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder, for the purpose mounting components in the variety of positions found on land vehicles (automobiles).

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Claims 6-13 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Schroeder U.S. Patent 1257536.

Claim 6. Murray discloses that the means for mounting comprises a plurality of holes but does not specify what type of fasteners and washers are used. Murray further suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs.1 and 2) a means for mounting that includes a ball washer assembly received in a concave cup (portion of 4 receiving 8) formed adjacent a distal end of one or more bores (hole portion of 4 receiving 10). Schroeder states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to adapt the Murray means for mounting to a land vehicle, as suggested by Murray, by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder, for the purpose mounting components in the variety of positions found on land vehicles (automobiles).

Claim 7. Murray as modified by Schroeder suggests that the plurality (Murray) of ball washer (Schroeder) assemblies includes a second threaded bolt (Schroeder, 10) formed with a first diameter.

Claim 8. Murray as modified by Schroeder suggests that the plurality of ball washer assemblies includes a ball washer (Schroeder, 8).

Claim 9. Schroeder teaches that the ball washer is formed with a substantially hemispherical exterior surface (top of 8), an interior surface (bottom of 8), and a duct (hole

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within 8) between the substantially hemispherical exterior surface and the interior surface formed with a second diameter larger than the first diameter of the second threaded bolt.

Claim 10. Schroeder teaches a nut assembly (15).

Claim 11. Murray discloses a coupler system, comprising: a base (40) formed with opposing yokes (yoke portions of 40 receiving 41); means (57) formed in the base for mounting the base on a curved surface; a boom-swivel device (42, 71, 55) detachably fixable to the base for securing a shaft (200) to the coupler system. Murray discloses that the means for mounting comprises a plurality of holes but does not specify what type of fasteners and washers are used. Murray further suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs.1 and 2) a means for mounting that includes a ball washer assembly received in a concave cup (portion of 4 receiving 8) formed adjacent a distal end of one or more bores (hole portion of 4 receiving 10). Schroeder states (p.2, ll.55-95) that ball washer means for mounting are beneficial for mounting components in the variety of positions found on land vehicles (automobiles). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to adapt the Murray means for mounting to a land vehicle, as suggested by Murray, by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder, for the purpose mounting components in the variety of positions found on land vehicles (automobiles).

Claim 12. Murray discloses that the opposing yokes are formed with opposing apertures (51).

Claim 13. Murray discloses that the mounting means includes a bore (57) formed in the base.

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Claim 16. Murray as modified by Schroeder suggests that the plurality (Murray) of ball washer (Schroeder) assemblies includes a bolt (Schroeder, 10) formed with a first diameter.

Claim 17. Murray as modified by Schroeder suggests that the plurality of ball washer assemblies includes a ball washer (Schroeder, 8) formed with a duct (9) having a second diameter larger than the first diameter of the bolt.

Claim 18. Murray as modified by Schroeder suggests that the plurality of ball washer assemblies includes a nut assembly (15).

Claim 19. Murray discloses that the boom-swivel device includes at least one tub (100) adjustably connectable to the opposing yokes.

Claim 20. Murray discloses that the boom-swivel device includes a plug (42, 71) repositionably attachable to the tub.

Claim 21. Murray discloses that the boom-swivel device includes a neck (55) for supporting a shaft (200) rotatably insertable in the plug.

Claim 22. Murray discloses that the boom-swivel device includes a clevis mechanism (clevis between 55 and 71) engageable with the plug and the neck.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray U.S. Patent 5697320 (see marked-up figures above) in view of Schroeder U.S. Patent 1257536, as applied to claim 13 above, and further in view of Landgrebe U.S. Patent 5704749.

Claim 14. Murray does not disclose a recess. Landgrebe teaches (fig.1 and cols.3-4) a recess (55) formed in one end of a bore (portion of B receiving A), which is beneficial for improving the alignment of a fastener within a bore during assembly (col.4, ll.1-20). Therefore,

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it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the coupler of Murray to include, a recess, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly.

Claim 15. Schroeder teaches a mounting means that includes a cup (portion of 4 receiving 8) formed in the other end of a bore (5) for supporting the ball washer.

Response to Arguments

Applicant's arguments filed on 3/19/2004 with regard to the claim rejections have been fully considered but they are not persuasive.

The Applicant argues that the Murray means for mounting is not a plurality of ball washers. This is not persuasive since the Applicant's disclosure does not necessarily require that the means for mounting is a plurality of ball washers. The Examiner notes that the Applicant's specification (p.4, ll.1-2 and p.7, ll.8-9) states that in one embodiment the means for mounting can be one or more ball washer assemblies. However, the specification also states (p.9, ll.17-18) that this is only one of a number of possible embodiments of the Applicant's invention and that the structure shown in the drawings "is not a limitation of the present invention". Accordingly, the Applicant's Specification fails to set forth any specific guidelines for determining structural or functional equivalency for the mounting means. The Murray mounting means (57) is equivalent to the Applicant's ball washers as a means for mounting since it mounts a base (40) on a curved surface (curved surface of watercraft as seen in fig.1). Note that the surface of the Murray watercraft (as seen in figure 1) is curved in as much as the Applicant's watercraft surface is curved (as seen in Applicant's figure 14).

The Applicant argues that Murray does not disclose a tub since the Murray patent does not use the Applicant's preferred nomenclature (i.e. tub). This is not persuasive. Murray discloses a tub (100) adjustably connectable to a base (40). Element (100) of Murray is a tub in that it has all of the claimed structure of the Applicant's tub. Rejection under 35 U.S.C. 102 or 103 does not require that prior art use the exact nomenclature used by the Applicant, only that the same claimed structure be present.

The Applicant argues that the Murray plug (42, 71) is not repositionably attachable to a tub and that it doesn't provide for rotatable insertion of the neck. This is not persuasive. The Murray plug (42, 71) is repositionably attachable to a tub (100) via rotation within 100. Murray further discloses a neck (55) rotatably insertable in the plug (42, 71).

The Applicant argues that the prior art does not disclose various details shown in the drawing and described in the specification that are not claimed (e.g. chamber, body, etc.). This is not persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues that element (55) of Murray cannot be the neck since the Examiner has already identified element (55) as being tub (100). This is not persuasive. The marked-up drawings clearly show that the Murray tub (100) and Murray neck (55) are two separate elements.

The Applicant argues that the Murray neck (55) is not insertable in the plug. This is not persuasive since the marked-up figures clearly show a plug [42 (including upper portion of 42)

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and 71] repositionably attached to the tub (100); a neck (55) rotatably inserted in the plug [42 (including upper portion of 42) and 71].

The Applicant argues that Murray does not disclose a curved surface. This is not persuasive since the Murray watercraft surface as seen in Murray's figure 1 is curved in as much as the Applicant's watercraft surface as seen in Applicant's figure 14 is curved.

The Applicant argues that the prior art is nonanalogous to the Applicant's invention. This is not persuasive. It has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Applicant's invention and the prior art are in the field of variably positionable couplers.

The Applicant argues that there is no motivation or suggestion to combine Murray with Schroeder. This is not persuasive. Murray suggests (col.2, ll.61-65) adaptation for use on land vehicles but does not detail such adaptation. Schroeder teaches (figs.1 and 2) such adaptation by the use of ball washer means which are beneficial for mounting components in the variety of positions found on land vehicles (automobiles).

The Applicant argues that Murray and Schroeder are not bodily incorporable. This is not persuasive. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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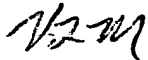
Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701.

The Examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



VLM

March 17, 2005



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